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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,819	07/15/2003	Takaaki Matsuji	0042-0484P	5901
2292	7590	07/02/2004		EXAMINER
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				WALLS, DIONNE A
			ART UNIT	PAPER NUMBER
			1731	

DATE MAILED: 07/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/618,819	MATSUJI ET AL.
	Examiner Dionne A. Walls	Art Unit 1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 05 April 2004.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1,2 and 5-22 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,2,5,6,8-16 and 18-22 is/are rejected.
- 7) Claim(s) 7 and 17 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-2, 5-6, 8-16, and 18-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goodman et al (US. Pat. No. 4,998,543).

Goodman et al discloses a smoking article exhibiting reduced sidestream smoke and, inherently, low fire-spreading characteristics since it teaches a wrapping of a tobacco rod in a double (i.e. inner and outer) layer of paper. The goal of the configuration of the inner wrapper is to slow down the burn rate of said wrapper, so it is provided with low calcium carbonate loading (corresponding to the claimed "loading material"), and little or no burn chemical additive. The outer wrapper is configured to have a higher burn rate and is provided with 2-10% by weight of a burn chemical additive and a higher calcium carbonate filler loading of 30-40%. (see entire document). While Goodman et al does not specifically state that the inner and outer wrappers have the claimed conductivity values, Applicant has, at least, inferred, in the instant specification, that low calcium carbonate loading and burn additive amounts will increase heat conductivity, and high calcium carbonate loading and burn additive amounts will lower same. Therefore, the inner and outer wrappers of Goodman et al obviously have dissimilar conductivity values, since their filler and burn chemical values

are distinctively different. And, based on Goodman et al's teaching that it is desirable to have an inner wrap with a low burn rate (see col. 2, lines 15-19), it follows that one having ordinary skill at the time of the invention would arrive at the claimed calcium carbonate amounts, for the inner wrap, after routine experimentation, to determine the optimal range which would allow for reduced burning of the inner wrap to reduce the visible sidestream smoke. Thus, since the claimed loading amounts have been met, the claimed conductivity values should inherently and/or obviously also be met.

Regarding claims 2 and 15, once the cigarette of Goodman et al is smoked, the tobacco section would inherently exhibit the claimed linear static burn rate.

Regarding claim 5, the inner wrap of Goodman et al has a porosity in the range of 20 – 40 CORESTA – which falls in the range of the claimed 5-30 CORESTA.

Regarding claim 8 and 18, the inner wrap of Goodman has a basis weight of 15-25 grams per square meter – which falls in the range of the claimed 15-35 grams per square meter.

Regarding claim 13, the outer wrap of Goodman et al has a porosity in the range of 50-100 CORESTA – which falls in the range of the claimed 10-100 CORESTA.

Regarding claims 14, the outer wrap of Goodman has a basis weight of 30-70 grams per square meter – which falls in the range of the claimed 20-70 grams per square meter.

***Allowable Subject Matter***

3. Claims 7 and 17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

4. Applicant's arguments filed 4/5/2004 have been fully considered but they are not persuasive.

- Applicant argues that Goodman et al clearly does not teach or suggest the feature of the inside wrapper paper sheet containing 0 to 0.5% by weight of a loading material, and that since it states that the inner wrapper contains about 2-15% by weight of a calcium carbonate loading, there is no suggestion to increase or decrease the amount of calcium carbonate beyond the cited range. However, the Examiner disagrees. Absent a teaching away, in the Goodman reference, one having ordinary skill in the art would have been motivated to go outside of the stated range (especially since the low end of the range is preceded by the word "about" ) to find the optimum loading to achieve the desired characteristics of the paper wrapper. Further, Applicant has not presented any evidence of "unexpected results", or any evidence that would suggest that one of ordinary skill in the art would not have experimented with loading percentages in amounts outside of the disclosed range.

- Further, Applicant argues that the Examiner is suggesting that Applicant's finding that there is a correlation between heat conductivity of a wrapper and its fire-spreading property is known in the background art, i.e. the Examiner is relying on

Applicant's own teachings to modify the prior art of record. However, this is not the case. The Examiner is merely stating, by pointing out inferences in Applicant's disclosure, that the prior art, namely the Goodman reference, already teaches what Applicant is instantly disclosing since the same loading material amounts, porosity values, basis weight values, and burn control agents disclosed/suggested as present in Goodman wrapper are present in the instant wrapper. So, it follows (absent some evidence to the contrary) that the heat conductivity values would also be the same.

***Conclusion***

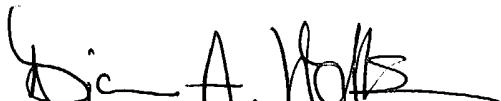
5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dionne A. Walls whose telephone number is (571) 272-1195. The examiner can normally be reached on Mon-Fri, 7AM - 4:30PM (Every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on (571) 272-1189. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Dionne A. Walls  
Primary Examiner  
Art Unit 1731

June 28, 2004